REMARKS

In response to the Office Action dated June 24, 2004, Assignee respectfully requests reconsideration based on the above amendments and the following remarks. Assignee respectfully submits that the amended claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1-4, 7, 9-12, 14-16, and 21-26 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,631,360 to Cook. Claims 5, 6, 8, 13, 17, 18, 20, and 27 were rejected under 35 U.S.C. § 103 (a) as being obvious over *Cook*. The Assignee shows, however, that the amended claims are patentably distinguishable over *Cook*.

Discussion with Examiner Alvarez

Examiner Alvarez discussed this amendment. On Tuesday, August 31, 2004 Examiner Alvarez and Scott Zimmerman discussed these claim amendments. Examiner Alvarez agreed that the claim amendments overcame the cited reference to *Cook*. Examiner Alvarez also said she would perform another search.

Rejection of Claims under 35 U.S.C. § 102 (e)

The Office rejected claims 1-4, 7, 9-12, 14-16, and 21-26 under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,631,360 to Cook. A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, amended, independent claims 1 and 15, and thus the dependent claims thereunder, are patentably distinguishable over *Cook*. The reference to *Cook* does not anticipate claims 1-26, so the Assignee respectfully requests that Examiner Alvarez remove the 35 U.S.C. § 102 (e) rejection of the claims.

Independent claims 1 and 15 have been amended. Both independent claims 1 and 15 describe a method for marketing incentives to cable television viewers. Claims 1 and 15 relate a user's cable television viewing selections to credit card purchase records. Amended claim 1 is reproduced below:

1. (Currently Amended) A method for marketing, comprising:

defining a match between a user classification and an incentive;

receiving from a set-top box user data associated with a user's cable television viewing selections ~~terminal from a plurality of sources~~;

receiving the user's credit card purchase records;

classifying the user in a user classification when the user's cable television viewing selections relate to the user's credit card purchase records; and

transmitting the incentive to the user if a match is defined between the user classification and the incentive.

Independent claim 15 includes similar features. The user's cable television viewing selections are received from a set-top box, and these viewing selections are related to the user's credit card purchases. An incentive is transmitted to the user if a match is defined between the user classification and the incentive.

Cook is completely silent to marketing incentives to cable television viewers. Examiner Alvarez is correct — *Cook* describes a method of targeting a "stimulus" in Internet advertising (*see, e.g.,* U.S. Patent 6,631,360 to Cook at column 4, lines 4-15; column 4, lines 18-25; and column 8, lines 26-39). The patent to *Cook*, however, fails to contemplate that cable television viewing selections can be related to credit card purchases. While *Cook* does state that Cook's invention can be applied to "more traditional venues" (column 8, lines 36-39), *Cook* fails to realize that a user's cable television viewing selections can be received from a set-top box, as independent claims 1 and 15 require. Because *Cook* fails to teach these features, *Cook* cannot anticipate independent claims 1 and 15. The Assignee, then, respectfully asks Examiner Alvarez to remove the § 102 rejection and to allow the pending claims.

Rejection of Claims under 35 U.S.C. § 103 (a)

The Office rejected claims 5, 6, 8, 13, 17, 18, 20, and 27 under 35 U.S.C. § 103 (a) as being obvious over *Cook*. If the Office wishes to establish a *prima facia* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As this response explains above, *Cook* does not teach or suggest all the features of independent claims 1 and 15.

Claims 1 and 15 are not obvious in view of *Cook*. Both independent claims 1 and 15 receive a user's cable television viewing selections from a set-top box, and these viewing selections are related to the user's credit card purchases. The patent to *Cook*, as explained above, fails to contemplate that cable television viewing selections can be related to credit card purchases. *Cook* fails to realize that a user's cable television viewing selections can be received from a set-top box, as independent claims 1 and 15 require. Thus, *Cook* in no way teaches or suggests the features of claims 1 and 15. One of ordinary skill in the art, then, would not find it obvious to modify the teachings of *Cook* to target incentives to cable television viewers. Because *Cook* does not teach or suggest all the features of independent claims 1 and 15, *Cook* cannot obviate the pending claims. The Assignee, then, respectfully requests removal of the 35 U.S.C. § 103 (a) rejection.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or *scott@scottzimmerman.com*.

Respectfully submitted,

Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390